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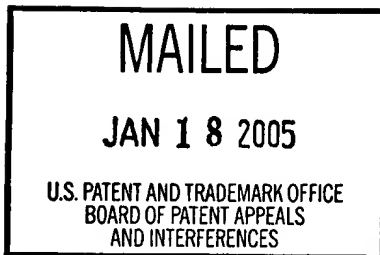
The opinion in support of the decision being entered today
was **not** written for publication in a law journal and
is **not** binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH LAWRENCE ACCARDI, DEBORAH ANN BABULA,
GEORGE PETER GESIOR, HENRY JOHN HUMMEL JR.,
IANNE MAE HOWARDS KORITZINSKY,
SCOTT MATT MCOLASH, GEORGE TZORTZOS and
HUBERT ANTHONY ZETTEL



Appeal No. 2004-0552
Application No. 09/199,506

ON BRIEF

Before RUGGIERO, DIXON and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the
examiner's rejection of claims 1 through 44.

The Invention

The invention relates to a system for a medical diagnostic imaging system in which the user of the system can transmit service requests to a centralized service center. See page 4 of appellants' originally filed specification.

Claim 1 is representative of the invention

1. A system for servicing a medical diagnostic apparatus, the system comprising:

a diagnostic apparatus including a service server for originating a service request for operational servicing of the diagnostic apparatus and a network communications module for transmitting the service request;

a service facility remote from the diagnostic apparatus, the service facility including a network server for receiving the service request and exchanging data with the diagnostic apparatus in response to the service request.

References

Derzay et al (Derzay)	6,434,572	Aug. 13, 2002 (filed Nov. 25, 1998)
Jago et al. (Jago)	5,938,607	Aug. 17, 1999
Friz et al. (Friz)	5,786,994	Jul. 28, 1998
Love et al. (Love)	5,629,871	May 13, 1997

Rejections at Issue

Claims 1 through 6, 8 through 13, 15 through 23 and 25 through 44 stand rejected under 35 U.S.C. § 103 as being unpatentable over Friz in view of Jago.

Claims 7, 14 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Friz in view of Jago and Love.

Claims 1-44 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of Derzay.

Claims 1-44 stand rejected under 35 U.S.C. § 102 (f) as being anticipated by Derzay.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs¹ along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra*, we affirm the following rejections set forth by the examiner: a) the rejection of claims 1 through 44 under 35 U.S.C. § 102(f); b) the rejection of claims 1 through 44 under the judicially created doctrine of obviousness-type double patenting; c) the rejection of claims 1 through 14 under 35 U.S.C. § 103:

¹ This decision is based upon the Appeal Brief received April 10, 2003 (certified as being filed on April 7, 2003, in accordance with 37 C.F.R. § 1.8(a)), and the Reply Brief received August 25, 2003 (certified as being filed on August 18, 2003).

We reverse the examiner's rejection of claims 15 through 44 under 35 U.S.C. § 103.

Grouping of the Claims

At the outset, we note that appellants state on page 7 of the brief that:

In regard to Issue No. 1 [rejection of claims 1 through 6, 8 through 13, 15 through 23 and 25 through 44 under 35 U.S.C. § 103], independent claims 1, 8, 15, 22, 29 and 36 will stand or fall independently of one another. Dependent claims 2-6, 9-13, 16-21, 23, 25-28, 30-35 and 37-44 will stand or fall with their respective independent claims.

In regard to Issue No. 2 [rejection of claims 7, 14 and 24 under 35 U.S.C. § 103], dependent claims 7, 14 and 24 will stand with their respective independent claims, but will not fall with them.

In regard to Issue No. 3 [rejection of claims 1-44 under the judicially created doctrine of obviousness-type double patenting], independent claims 1, 8, 15, 22, 29 and 36 will stand or fall independently of one another. Dependent claims 2-7, 9-14, 16-21, 23-28, 30-35 and 37-44 will stand or fall with their respective independent claims.

In regard to Issue No. 4 [rejection of Claims 1-44 under 35 U.S.C. § 102 (f)], independent claims 1, 8, 15, 22, 29, and 36 will stand or fall independently of one another. Dependent claims 2-7, 9-14, 16-21, 23-28, 30-5 and 37-44 will stand or fall with their respective independent claims.

37 C.F.R. § 1.192(c) (7) (July 1, 2002) as amended at 62 Fed. Reg. 531196 (October 10, 1997), which was controlling at the time of appellant filing the brief, states:

For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a

statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c) (8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We note that with regard to the rejections based upon 35 U.S.C. § 103 (issues 1 and 2), and the judicially created doctrine of obviousness-type double patenting (issue 3), appellants have provided separate arguments for independent claims 1, 8, 15, 22, 29 and 36. However, with regard to the rejection based upon 35 U.S.C. § 102 (issue 4), appellants have not provided separate arguments.

Accordingly, for the rejections based upon 35 U.S.C. § 103, we will group the claims as follows:

Group A1) claims 1 through 6, with claim 1 as representative of that group.

Group A2) claims 8 through 13, with claim 8 as representative of that group.

Group A3) claims 15 through 21, with claim 15 as representative of that group.

Group A4) claims 22, 23 and 25 through 28, with claim 22 as representative of that group.

Group A5) claims 29 through 35, with claim 29 as representative of that group.

Group A6) claims 36 through 44, with claim 36 as representative of that group.

Group A7) claims 7, 14 and 24, with claim 7 as representative of that group.

For the rejections based upon the judicially created doctrine of obviousness-type double patenting, we will group the claims as follows:

Group B1) claims 1 through 7, with claim 1 as representative of that group.

Group B2) claims 8 through 14, with claim 8 as representative of that group.

Group B3) claims 15 through 21, with claim 15 as representative of that group.

Group B4) claims 22, through 28, with claim 22 as representative of that group.

Group B5) claims 29 through 35, with claim 29 as representative of that group.

Group B6) claims 36 through 44, with claim 36 as representative of that group.

For the rejection based upon 35 U.S.C. § 102, we group claims 1-44 (Group C1), with claim 1 as representative of that group.

Rejections under 35 U.S.C. § 103.

Appellants' arguments directed to the rejection of claims 1 through 6, 8 through 13, 15 through 23 and 25 through 33 under 35 U.S.C. § 103 are on pages 7 through 38 of the brief.

Claim Group A1 (Claims 1 through 6)

With respect to claim 1, appellants argue, on page 11 of the brief, that:

[T]he references are believed to be absolutely devoid of any teaching or suggestion of *operational servicing* of the medical diagnostic system via *service requests*, as recited in claim 1. As noted above, claim 1 recites a "service request for operational servicing of the diagnostic apparatus." With regard to the Jago et al. reference, the Examiner admitted that, "Jago does not explicitly disclose the requested [sic, request] is an [sic, for] operational servicing of diagnostic apparatus service." Indeed, the Jago et al. reference is limited to techniques for *treating or diagnosing patents*.

The Examiner's rejection of claims 1 through 6, 8 through 13, 15 through 23 and 25 through 44 is set forth on pages 5 through 14 of the answer. On page 6 of the answer, the examiner asserts that Jago teaches

[A] *service facility, remote from the diagnostic apparatus* (the manufacturer, Col. 8-lines 5-26), *the service facility including a network server for receiving the service request and exchanging data with the diagnostic apparatus in response to the service request* (the manufacturer returning EM [electronic message] the ULS [ultrasound system] and organizing web page for exchanging information with the ULS, this teaching implied at least a web server is at the manufacturer, Col. 8, lines 49-52.)

Even though, Jago taught several means and method steps for generating and communicating, error log, report, image, etc. in form EM from the ULS to its manufacturer and in response, the manufacturer returning EM to the respective ULS. Jago teaching fails [sic, falls] short of explicitly say[ing] that the information, which is sent to the manufacturer including a request for servicing,

e.g., repairing of the ultrasound equipment i.e. “*servicing of diagnostic apparatus.*”

In rebuttal to the examiner’s statement, appellants argue, on page 2 of the reply brief, that the examiner’s characterization of the electronic messaging system:

misses the point. As discussed throughout the present application, and in arguments advanced by the Appellants repeatedly, existing systems that automatically capture information and transmit the information for remote processing do not permit a service request to be generated for operational servicing of the equipment.

We are unconvinced by appellants’ arguments as we find that Jago does teach originating service requests as claimed. Claim 1, includes the limitation of “originating a service request for operational servicing of the diagnostic apparatus.” Claims will be given their broadest reasonable interpretation, limitations appearing in the specification will not be read into the claims. *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellant’s disclosure to properly determine the given meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet*

America Inc v. Kee-Vet Laboratories Inc., 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “[T]he terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” **Texas Digital Sys, Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002). “Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.” **Texas Digital Systems, Inc. v. Telegenix, Inc.**, 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002). (“[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty.”); *Id.* (citing **Liebscher v. Boothroyd**, 258 F.2d 948, 951, 119 USPQ 133, 135 (C.C.P.A. 1958) (“Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.”)).

We find that the term “service request” is explicitly defined on page 7 of appellants’ specification: “as used herein, the term ‘service request’ is intended to include a wide range of inquiries, comments, suggestions and other queries or messages generated by a diagnostic system or an institution in which a system

is disposed or managed.” We do not find a definition for the term “operational servicing” in appellants’ specification. The dictionary definition of “servicing” is “supplying maintenance and repair.”² This definition is consistent with appellants’ specification, see for example page 2 “[t]o ensure proper operation, the systems are serviced regularly by highly trained personnel who address imaging problems, configure and calibrate the system....” Accordingly, we find that the scope of claim 1 includes, originating at the diagnostic device, a service request, which may include inquiries, comments, suggestions and other queries or messages generated by the diagnostic system, for operational servicing, supplying maintenance or repair, of the diagnostic equipment.

We find, contrary to appellants’ argument, that Jago is not limited to techniques for treating or diagnosing patents, and that Jago also teaches transmission of a service request to a service center. Jago teaches an ultrasound machine, a medical diagnostic system, which includes an application that allows the user to perform system diagnostics (see Jago, column 5, lines 60-62). The ultrasound system can use the electronic messaging system to send the error log to the system manufacturer or repairman who can then review the error log, determine if repairs are needed and send a reply to the system operator (see Jago, column 8, lines 5-26). Jago teaches that the system

² Definition taken from Random House College dictionary, Revised Edition 1982.

operator can send the error log (Jago, column 8, lines 7 and 8) or the error log can be automatically sent. We agree with the examiner that “Jago [sic, Jago’s] teaching fails [sic, falls] short of explicitly say [sic, saying] that the information, which is sent to the manufacturer included [sic, includes] a request for servicing, e.g. repairing of the ultrasound equipment i.e. ‘*servicing of diagnostic apparatus*’” (page 6 of answer). We consider, however, Jago’s teaching that “[t]he ultrasound system operator can send the system error log to the system manufacturer, even accompanied by images acquired at the time of a problem to enable the manufacturer to remotely diagnose system performance problems” (Jago, column 8 lines 7 to 11) to be tantamount to a request for maintenance or repair. Nonetheless, the examiner relies upon Friz to teach that a request for service should be generated when errors occur and are entered into an error log, and for the reasons stated *infra* we concur. Thus, we find that the error logs of Jago are within the scope of the claimed “service requests,” as stated *supra* the scope of the term “service request” includes comments and messages generated by the diagnostic system. Accordingly, we hold that Jago teaches the limitations of originating a service request for the diagnostic apparatus as recited in claim 1.

We are not convinced by appellants’ argument on page 12 of the brief that Friz does not teach the claimed “service request for operational servicing” and as such the combination of Friz and Jago fails to teach, “service request.”

As stated *supra* we find that Jago teaches the limitation of a “service request.” The examiner asserts, on page 6 of the answer, that Friz teaches that when an error in the operation of the diagnostic device occurs, a request for service is generated. We agree. Friz teaches a system that monitors laser imaging devices and has a remote monitoring system (see Friz, abstract). Friz teaches that when errors in the device occur, a request for a service technician should be generated (see column 12, lines 22-26). In combination with Jago, we find that this teaching would suggest to one of ordinary skill in the art, that the act of sending a system error log to a repairman or manufacturer, by the system operator as taught by Jago, should include a request for service.³

On page 12 of the brief, appellants argue “the combination of the references fails to include ‘exchanging data with the diagnostic apparatus in response to the service request.’” Appellants argue, on page 13 of the brief, that Jago teaches exchanging information related to treatment of diagnosis of patients and not operational servicing, thus Jago fails to disclose exchanging data in response to a service request. Further, on page 13 of the brief, appellants argue that Friz “does nothing to cure the deficiencies of Jago et al.”

³ While we acknowledge that column 8 lines 22-23 of Jago teach that the manufacturer or repairman can review the error log to see if the information indicates that a repair or adjustment is necessary, we do not consider this to imply that the message from the user is not a service request, but rather we consider this to be a step in determining the resolution of the service request.

The examiner's response to this argument, on page 15 of the answer, asserts that Jago teaches exchanging data in that the ultrasound and the manufacturer interact via electronic messages, citing Jago, column 8, lines 15-26 and lines 49-57.

We concur with the examiner's statement. As discussed *supra*, we find that Jago teaches originating a service request from the diagnostic apparatus. Further, we find that Jago teaches that in response to the service request being transmitted to the manufacturer, the manufacturer can communicate with the system operator through the electronic messaging (see Jago, column 8, lines 23-26). We consider the manufacturer's electronic communication with the system operator to meet the claimed exchanging data with the diagnostic apparatus. Further, we note that Jago's feature whereby images accompany the error log, discussed *supra*, also meets the claim limitation of exchanging data, as we find no limitation in claim 1 which limits the direction in which the data is exchanged.

On pages 13 through 16 of the brief, appellants argue that there is no motivation to combine Jago and Friz. On page 15 of the brief, appellants assert that Jago is "limited to techniques for *treating or diagnosing patients*" and that:

The Friz et al. reference simply offers an image quality system, which includes a centralized server that pulls raw data from a group of laser imagers. Friz et al. col. 1, lines 50-56. The Friz et al. reference teaches utilizing a single performance monitoring system to poll the laser imagers with the laser imagers not communicating unless polled. Friz et al., col 11, lines 55,-57. This teaching of a single centralized controller is in direct conflict with Jago et al. which teaches that the ultrasound systems communicate with other devices, such as hospital information systems and reference image library.

We disagree with appellants' arguments. As stated *supra*, we find that Jago teaches that the medical diagnostics system operator can send the error log to a repairman, which reads on appellants' claimed step of originating a service request. Further, we find that Jago's teaching of communicating an error log to a repairman to be tantamount to, if not a suggestion, that the communication is a request for servicing. The examiner has relied upon Friz to teach that when an error log or problem is found, a service request is initiated. We concur, and find that Friz teaches that error reports are used to generate requests for servicing, see column 12 lines 22-25. While we agree with appellants that Friz's method of transmission of the operational information, involving polling of the equipment by a central computer, is different than the claimed originating a service request, as stated *supra*, we find Jago teaches originating a service request at the diagnostic unit. We find that Friz teaches that requesting operational servicing when an error is found is important, as it will allow the diagnostic equipment to operate with greater accuracy and reduce

the need for patients to be subjected to repetitive diagnostic procedures (see Friz, column 1, lines 63 to column 2 line 10). Accordingly, we will sustain the examiner's rejection of claims 1 through 6 (group A1) under 35 U.S.C. § 103.

Claim Group A2 (Claims 8 through 13)

Appellants' arguments directed to the examiner's rejection of representative claim 8 under 35 U.S.C. § 103 are on pages 17 and 18 of the brief. Appellants argue, on page 17 of the brief, that Jago and Friz do not suggest initiating a service request for operational servicing. Further, appellants argue, on page 18 of the brief, that there is no motivation to combine Jago and Friz.

We are not convinced by appellants' arguments. We find that claim 8 contains the limitation of "initiating a service request for operational servicing of the diagnostic system" which has a similar scope to the claim 1 limitation of "originating a service request...." As discussed *supra*, with respect to the rejection of claim 1, we find that the combination of Jago and Friz teach the limitation of "initiating a service request" and that the references provide the suggestion to be combined in the manner asserted by the examiner. Accordingly, we will sustain the rejection of claims 8 through 13 (group A2) under 35 U.S.C. § 103.

Claim Group A3 (Claims 15 through 21)

Appellants' arguments directed to the examiner's rejection of claim 15 under 35 U.S.C. § 103 are on pages 19 through 23 of the brief. On page 21 of the brief, appellants argue that the combination of Jago and Friz does not teach a service server for accessing data representative of a serviceable operation condition of a first station, service server for accessing data representative of a serviceable operation condition of a second station, and a server for interactively exchanging operational service data with the first and second stations.

The examiner, states on pages 7 and 8 of the answer, that Jago teaches a first medical station figure 2, element 200 and a second medical station figure 2, element 202, further, the manufacturer's system which the stations electronically message, is considered to be equivalent to the claimed server for interactively exchanging operational service data from the first and second stations.

We disagree with the examiner's rationale. Independent claim 15 contains the limitations "a first medical diagnostic station of a first modality, the first medical diagnostic station including a service server for accessing data representative of a serviceable operational condition of the first station; a second medical diagnostic station of a second modality different from the first

modality, the second medical diagnostic station including a service server for accessing data representative of a serviceable operational condition of the second station.” Claims 16 through 21 all ultimately depend upon claim 15. Thus, claims 15, and 16 through 21, require the two diagnostic stations to be of different modality. We interpret the term modality to refer to a mode of diagnostic testing performed by the diagnostic device which is consistent with appellants’ specification which, on page 1, identifies several modes of diagnostic testing. While we concur with the examiner, that Jago teaches several diagnostic stations can communicate with a central manufacturer system, we do not find that Jago teaches that diagnostic devices of different modalities communicate service requests to the same server. Similarly, we find no teaching in Friz, that diagnostic devices of different modalities communicate service requests to the same server. Accordingly, we will not sustain the examiner’s rejection of claims 15 through 21 (group A3).

Claim Groups A4, A5 (Claims 22, 23 and 25 through 35)

Appellants’ arguments directed to the examiner’s rejection of representative claims 22 and 29 under 35 U.S.C. § 103 are on pages 23 through 32 of the brief. Appellants argue, on page 25 of the brief, that the rejection of claim 22 is improper because the combination of Jago and Friz does not teach originating a service request for operational servicing of the medical diagnostic

system (appellants make a similar argument concerning the rejection of claim 29 on page 30 of the brief). Additionally, on page 26 of the brief, appellants argue that the combination of Jago and Friz does not teach transmitting the service request to a service facility (appellants make a similar argument concerning the rejection of claim 29 on page 31 of the brief). We are not convinced by this argument for the reasons stated *supra*, with respect to the rejection claim 1.

Appellants' argue on page 26 of the brief that the combination of Jago and Friz:

fails to disclose "acknowledging receipt of the service request automatically by the service facility via an electronic message to the medical diagnostic system." As discussed above with regard to the alleged elements that are "well known", the Examiner recognized that the combination fails to include all of the recited features. In fact, the examiner admitted that the combination of the Jago et al. and the Friz et al. teachings fail to disclose transmitting an acknowledgement message. Specifically, the Examiner stated with regard to the rejection of claim 18, which is the basis for the rejection of claim 22 that "it does not explicitly disclose transmit an acknowledgement message." Moreover the Appellants also stress that neither reference teaches or suggests a *service request* as recited in claim 22. Furthermore, the recited feature of "acknowledging receipt of the service request automatically" is a patentably distinct feature by way of its association with the forgoing feature of *service request for operational servicing*. Thus, the combination of the Jago et al. reference and Friz et al. reference clearly does not disclose or teach "acknowledging receipt of the service request automatically by the service facility via electronic message to the medical diagnostic system.

(Appellants make a similar argument concerning the rejection of claim 29 on pages 31 and 32 of the brief).

In the final rejection dated February 6, 2003, the examiner relied upon official notice that "sending acknowledgement was well known in the art," see page 9. In the answer, on page 9 and 18 the examiner re-stated the rejection and without relying upon official notice asserted that Jago teaches automatically acknowledging receipt of the service request and cited column 8, lines 23-29 to support his assertion.

We disagree with the examiner's rejection of these claims. Claim 22 includes the limitation "acknowledging receipt of the service request automatically by the service facility via an electronic messaging to the medical diagnostic facility." Claim 29 contains a similar limitation "automatically replying to the service message by the service facility to the medical diagnostic system via a return electronic message." As stated *supra*, we find that the combination of Jago and Friz teach originating a service request for operational servicing, and that there is an exchange of data in response to the receipt of the service request. While we agree with the examiner that Jago teaches that an acknowledgment of the service request can be communicated to the diagnostic system operator via electronic messaging, we do not find that Jago teaches that the acknowledgement is automatic. Further, we find no teaching in Friz or other evidence relied upon in the examiner's rejection to suggest the modification of

Jago to include the automatic acknowledgment of receipt of the service request. Accordingly, we will not sustain the examiner's rejection of claims 22, 23 and 25 through 35.

Claim Group A6 (Claims 36 through 44)

Appellants' arguments directed to the examiner's rejection of representative claim 36 under 35 U.S.C. § 103 are on pages 33 through 38 of the brief. Appellants argue, on page 36 of the brief, that the combination of the Jago and Friz references does not teach generating a first service request message in a first diagnostic system, generating a second service request in a second diagnostic system and transmitting the first and second service request messages to a service facility.

The examiner states on page 11 of the answer that Jago teaches a first medical station figure 2, element 200 and a second medical station figure 2, element 202 and the manufacturer's system which the stations electronically message is equivalent to the claimed server for interactively exchanging operational service data from the first and second stations.

We disagree with the examiner's rationale. Claim 36 contains the limitation of "a second diagnostic system of a second modality different from the first modality." As stated *supra*, with regard to claim 15, we do not find that the combination of Jago and Friz teaches or suggests diagnostic systems of

different modalities communicating service requests to the same facility.

Accordingly, we will not sustain the examiner's rejection of claims 36 through 44.

Claim Group A7 (Claims 7, 14 and 24)

The examiner has rejected claims 7, 14 and 24 under 35 U.S.C. § 103 as being unpatentable over Friz in view of Jago and Love, see pages 14 and 15 of the examiner's answer.

Initially, we note that claim 24 is dependent upon claim 23. As stated *supra*, we will not sustain the examiner's rejection of claim 23 as the combination of Friz and Jago does not teach or suggest the limitation "automatically replying to the service message by the service facility to the medical diagnostic system via a return electronic message." The examiner has not asserted, nor do we find that Love teaches this limitation. Accordingly, we will not sustain the examiner's rejection of claim 24.

We next consider the rejection of claims 7 and 14. Appellants' arguments directed to the examiner's rejection of claims 7 and 14 under 35 U.S.C. § 103 are on page 39 of the brief. Appellants argue, on page 39 of the brief that

The recited claims depend directly or indirectly from the base claims discussed above. The claims are believed to be clearly allowable over the cited references by virtue of this dependency. Appellants stress that the Love et al. reference does nothing to obviate the deficiencies of the Jago et al. and Friz et al. references as regards the failure to teach or suggest the recited features discussed above or to provide motivation to combine the references.

Claims 7 and 14 ultimately depend upon independent claims 1 and 8 respectively. As stated *supra* we find that the combination of Jago and Friz teach the limitations of Claims 1 and 8. Accordingly, we sustain the examiner's rejection of claims 7 and 14 under 35 U.S.C. § 103.

**Rejections under the Judicially created doctrine of
Obviousness-Type Double Patenting.**

The examiner's rejection of claims 1-44 over claims 1-59 of Derzay under the judicially created doctrine of obviousness-type double patenting is set forth on page 4 of the brief. On pages 21 through 25 of the answer, the examiner provides a claim-to-claim comparison for each of the appealed independent claims.

Claim Group B1 (Claims 1 through 7)

The Appellants' arguments directed to this rejection are on pages 40 through 45 of the brief and page 5 of the reply brief.⁴ Appellants argue, on page 41 of the brief, that claim 1 differs from the claims in Derzay as

the patent does not claim a diagnostic system configured to *originate* or *transmit a service request*. In particular, as illustrated in Fig. 4 of Derzay et al., a system for handling service requests is disclosed. Thus, the Derzay et al. reference simply does not claim

⁴ Appellants' arguments directed to this rejection in the reply brief address appellants' efforts in preparing the two patent applications. These arguments neither address any specific claim limitations nor refer to any facts of record in the application. Accordingly, we are unpersuaded by the arguments in the reply brief as appellants' efforts in preparing patent applications is of no consequence when considering an obviousness double patenting rejection.

a diagnostic apparatus including “a service server for originating a service request for operational servicing of the diagnostic apparatus” and “a network communications module for transmitting the service request,” as recited in claim 1.

On page 22 of the answer the examiner provides a comparison of Derzay claim 10 and appellants’ claim 1. Further, the examiner states “[t]he instant claim 1 is obviously broadened [sic, broader than] the scope of Derzay[‘s] claim 10.”

We concur with the examiner’s rejection. Claim 10 of Derzay includes the limitation “a service request composed by a medical person at a medical diagnostic station.” We find that this step reads on the limitation of “originating a service request.” Further, claim 10 of Derzay includes the limitation of “a communication circuitry ... for receiving the service request” which necessarily implies that the communication circuitry received a service request that was transmitted. Thus, we find that the appellants claim 1 is suggested by claim 10 in Derzay, and we accordingly sustain the examiner’s rejection of claim 1 and claims 2 through 7 which appellants have grouped together with claim 1. (group B1).

Claim Group B2 (Claims 8 through 14)

Appellants argue on page 42 of the brief, that claim 8 differs from the claims in Derzay because “Derzay et al. simply do not recite a diagnostic system having a station interface or an operator interface.”

On pages 22 and 23 of the answer the examiner provides a comparison of Derzay's claim 10 and appellants' claim 8. Further, the examiner states "[t]he instant claim 8 added inherent elements, e.g., operator interface, station interface, which are required for a medical person to compose [a] service request and are required for accessing performance information."

We concur with the examiner's rationale. Claim 10 of Derzay contains the limitation "a plurality of medical diagnostic stations," implicit in such a system is an interface to access data from the medical diagnostic test. Further, claim 10 includes the limitation "a service request composed by a medical person... communication circuitry ... for receiving the service request," implicit in this limitation is an interface through which the medical person composes the service request. Thus, we find that appellants' claim 8 is taught by claim 10 in Derzay, and we accordingly sustain the examiner's rejection of claims 8 through 14 (group B2).

Claim Group B3 (Claims 15 through 21)

Appellants argue on page 42 of the brief that claim 15 differs from the claims in Derzay because "Derzay et al. simply do not recite a diagnostic system having a service server for accessing data representative of a serviceable operational condition."

On pages 23 and 24 of the answer, the examiner provides a comparison of Derzay's claims 10 and 34 to appellants' claim 15. Further, the examiner

states, "such claim language is presented in the method claim 34 of the patent, which would have been obvious to one [with] ordinary engineering skill to apply the method for constructing a system or apparatus."

We concur with the examiner. We find that the system claimed in claim 10 of Derzay, a system for providing remote service to a plurality of medical diagnostic stations where each station has a server, and the method of Derzay claim 34, where service requests from medical diagnostic systems of different modalities are received at one remote location, suggests to the skilled artisan a system where there are multiple medical diagnostic systems of different modalities, each with a server for handling service requests. Thus, we find that the appellants' claim 15 is obvious over claims 10 and 34 of Derzay, and we accordingly sustain the examiner's rejection of claims 15 through 21 (group B3).

Claim Group B4 (Claims 22 through 28)

Appellants argue on page 42 of the brief that claim 22 differs from the claims in Derzay because "Derzay et al. do not claim a user interface or transmitting the service request as recited in claim 22."

As stated supra with respect to the rejection of claim 8, and claim 1, we find that implicit in claim 10 is an interface for originating a service request and transmission of that request. Thus, we find that the appellants' claim 22 is obvious over claim 10 of Derzay, and we accordingly sustain the examiner's rejection of claims 22 through 28 (group B4).

Claim Group B5 (Claims 29 through 35)

Appellants argue on page 43 of the brief that claim 29 differs from the claims in Derzay because “Derzay et al. do not claim linking the systems or transmitting the service message from the medical diagnostic system as defined by the claim.”

On pages 24 and 25 of the answer the examiner provides a comparison of Derzay’s claim 34 and appellants’ claim 29. Further, the examiner states “the linking and transmitting step [sic, are] inherent and implicit in the Derzay claimed receiving step.”

We concur with the examiner’s reasoning. We find that claim 34 of Derzay contains the limitation of remotely “receiving a plurality of service requests” first and second diagnostic systems and “transmitting reply messages” to the diagnostic systems. We find that these limitations imply a communication link through which the transmitting and receiving occur. Thus, we find that the appellants’ claim 29 is obvious over claim 34 of Derzay, and we accordingly sustain the examiner’s rejection of claims 29 through 35 (group B5).

Claim Group B6 (Claims 36 through 44)

Appellants argue on page 43 of the brief that claim 36 differs from the claims in Derzay because “Derzay et al. simply do not claim generating and transmitting the service request message from a first and second diagnostic system.”

We disagree. As stated *supra* with respect to claim 15, we find that claims 10 and 34 of Derzay suggest to the skilled artisan a system where there are multiple medical diagnostic systems of different modalities, each with a server for handling service requests. Thus, we find that the appellants' claim 36 is obvious over claims 10 and 34 of Derzay, and we accordingly sustain the examiner's rejection of claims 36 through 44 (group B6).

Rejections under 35 U.S.C. § 102.

Appellants' arguments directed to the examiner's rejection of claims 1-44 under 35 U.S.C. § 102 are on pages 43-45 of the brief and on pages 5 and 6 of the reply brief. Appellants assert, on page 44 of the brief that "[c]are was taken in preparing the present claims (which have not been substantially amended) and in naming the appropriate inventive entities on both the present application and the Derzay et al. patent. The respective inventors were well informed and all executed the required Declarations prior to filing." In the reply brief, on page 5, appellants reiterate this argument and cites the Manual of Patent Examining Procedure (MPEP) section 2137⁵ to support the assertion that the executors of an Oath or Declaration should be presumed to be the inventors.

⁵ We note that the section of the MPEP excerpted by appellant omits a key provision as discussed *infra*.

The examiner, in response, states on pages 26 and 27 of the answer "Derzay came to light, raised a question whether who invented the claims [sic, claimed] invention, since there are two inventive entities, provided nearly identical disclosures." Further, the examiner states, on page 27 of the answer, "[i]t became necessary to clarify this issue before examiner submission answer to the Broad [sic, Board] of Appeal [sic, Appeals]... As suggested over the telephone interview (paper no. 11), the 102(f) issue can be easily resolved by simply filing [an] affidavit, declaration to declare the exact inventive entity that invented the claims [sic, claimed] subject matter."

We concur with the examiner. Contrary to appellants' assertion, the examiner's rejection is in accordance with the MPEP 2137 which states:

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with *respect to the subject matter disclosed but not claimed in the patent* so as to justify a rejection under 35 U.S.C. 102(f). However, it is incumbent upon the inventors named in the application, in reply to an inquiry regarding the appropriate inventorship under subsection (f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter invented by the applicant rather than derived from the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. In *Re Katz* 687 F.2d 450, 455, 215 USPQ 14, 18 (CCPA 1982) (inquiry is appropriate to clarify an

ambiguity created by an article regarding inventorship and it is then incumbent upon the applicant to provide a "satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ...inventor" of the subject matter disclosed in the article and claimed in the application). (Emphasis added.)

As discussed *supra*, with respect to the rejection of based upon the judicially created doctrine of obviousness double patenting, we find that claim 10 of Derzay teaches the limitations of representative claim 1. Thus, as the claims and the disclosure of Derzay teaches the claim 1, we find the examiner followed the guidelines of the MPEP in rejecting claim 1 under 35 U.S.C. § 102(f). Appellants' arguments directed to this rejection do not address any differences between the claims that would justify the different inventive entities. We note that the examiner raised the issue of submitting a declaration to explain the differences in inventorship in an interview summary dated March 19, 2003 and in the answer (see page 27). Appellants have not complied except to state that an "inventorship inquiry was performed prior to the filing of both Derzay et al. and the present application to identify the correct inventors." We are not persuaded by appellants' arguments. We concur with the examiner's findings that the inventive entities of Derzay and the present application are different and the claims of Derzay teach the presently claimed invention. Absent, other evidence, such as a declaration, we find that the examiner's findings provide a *prima facie* case of anticipation and accordingly sustain the examiners rejection of claims 1-44 (group C1) under 35 U.S.C. § 102(f).

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants [see 37 CFR § 41.37]. Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1528-1529 (Fed. Cir. 2002) wherein the Federal Circuit stated that because the appellants did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. **See also *In re Watts***, 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

In view of the forgoing we will sustain the examiner's rejection of claims 1 through 14 under 35 U.S.C. § 103, the examiner's rejection of claims 1 through 44 under the judicially created doctrine of obviousness-type double patenting and the examiner's rejection of claims 1 through 44 under 35 U.S.C. § 102. We reverse the examiner's rejection of claims 15 through 44 under 35 U.S.C. § 103. The decision of the examiner to reject claims 1 through 44 is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

AFFIRMED

Joseph E. Ruggiero
JOSEPH E. RUGGIERO

JOSEPH F. RUGGIERO
Administrative Patent Judge


JOSEPH L. DIXON

JOSEPH L. DIXON
Administrative Patent Judge


ROBERT E. NAP
Administrative Director

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